



CUSTOMER NUMBER 27792

1 IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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#10

3 Appellants: Damon V. Danieli et al. Attorney Docket No: MICR0183  
4 Serial No: 09/515,793 Group Art Unit: 2131  
5 Filed: February 29, 2000 Examiner: Syed Zia  
6 Title: USE OF ONLINE MESSAGING TO FACILITATE SELECTION OF  
7 PARTICIPANTS IN GAME PLAY

8 APPEAL BRIEF

9 Bellevue, Washington 98004

10 January 26, 2004

11 TO THE DIRECTOR OF THE PATENT AND TRADEMARK OFFICE:

RECEIVED

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26 This is an appeal from a Final Rejection by Examiner Syed Zia of Group Art Unit 2131  
27 mailed on August 27, 2003. Appellant filed a timely Notice of Appeal on November 24, 2004.

28 The jurisdiction of this board is invoked under the provisions of 35 U.S.C. § 134 and  
29 37 C.F.R. §§ 1.191-192.

01/29/2004 AWND F1 00000035 09515793

30 01 FC:1402

330.00 OP

## REAL PARTY OF INTEREST

The real party of interest in this Appeal is hereby identified as Microsoft Corporation, since all rights and title in the invention and in the patent application on appeal have been assigned to Microsoft Corporation, as evidenced by a chain of title from the inventors in the patent application identified above, as shown below.

Assignment of all right and title in the present patent application was made by inventors **Damon V. Danieli, John R. Selbie, Matthew J. Stipes, John P. Pennock, and Drew C. Bamford** (assignments executed on May 17, April 17, May 18, April 17, and June 6, 2000, respectively) to **Microsoft Corporation**. Assignment of the first four above-named inventors (Danieli, Selbie, Stipes, and Pennock) was recorded in the U.S. Patent and Trademark Office on June 12, 2000 at Reel 010847, Frame 0977, and the assignment from inventor Bamford (as per the corrected notice of recordation dated October 5, 2000) was recorded in the U.S. Patent and Trademark Office on June 12, 2000 at Reel 010847, Frame 0986.

## RELATED APPEALS AND INTERFERENCES

No other appeals or interferences are known to Appellants, Appellants' undersigned legal representative, or by the assignee of this application that will directly affect or be directly affected by or have a bearing on the Board's decision in this pending appeal.

## **STATUS OF THE CLAIMS**

Claims 1-38 remain pending in the application on appeal. No claims have been allowed. Claims 1-38 have been rejected under 35 U.S.C. § 102(e), and Appellants hereby appeal the rejection of Claims 1-38.

## STATUS OF THE AMENDMENTS

In response to a first Office Action dated March 14, 2003, Claim 35 was amended to correct a typographical error. A Final Office Action was mailed on August 27, 2003 in which all of Claims 1-38 were rejected. No further amendments were submitted or entered subsequent to the Final Office Action.

## **SUMMARY OF THE INVENTION**

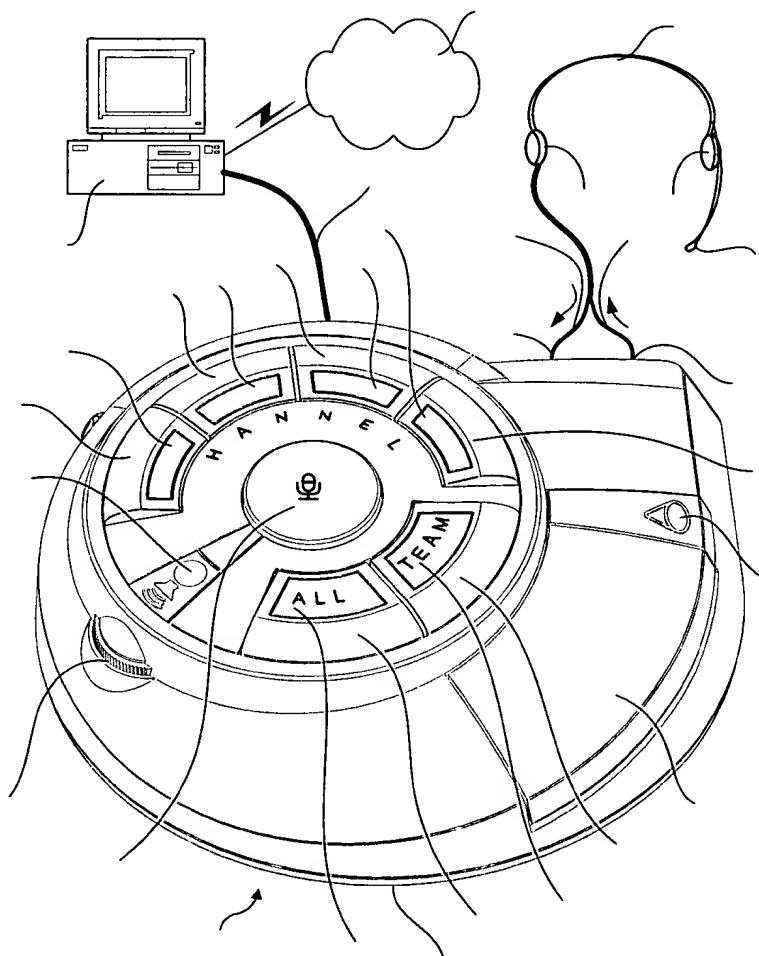
To better understand the invention claimed in the application on appeal, it may be helpful to first discuss the state of the art at the time the application was filed. As discussed under the Background of the Invention section of the application, from pg 1, line 8 through pg 4, line 2, multiplayer online games that are played over the Internet or some other network have become

1 extremely popular. Such games are typically hosted by either a third-party provider, such as  
2 Microsoft Corporation's Internet Game Zone™, or by an individual referred to as a "host player"  
3 (pg 2, line 5). To facilitate online game playing, it is necessary to enable players to initiate games or  
4 join games that are already in progress. When a third-party provider is acting as the host,  
5 prospective players will typically connect to the third-party provider over the network and be joined  
6 into a game or initiate the game through services provided by a server at the provider site. However,  
7 when an individual hosts a multiplayer game, the host must be able to communicate with prospective  
8 players to enable them to join a game being started or to join a game in progress. Internet Protocol  
9 (IP) addressing is commonly used to facilitate communications between a host player and other  
10 players, but as explained at pg 2, line 32 through pg 3, line 15, keeping track of dynamically  
11 changing IP addresses assigned to players and to a host player usually requires passing the IP  
12 addresses between the parties through separate email or telephone communications. Use of online  
13 lookup services provides some improvement in solving this problem, but does not provide a  
convenient way to invite players to join a game.

14 Accordingly, a more efficient method and system for enabling a host player to select one or  
15 more other participants to join in playing a multiplayer online electronic game was invented by  
16 Appellants, as defined by the claims of the present application on appeal. As discussed under the  
17 "Summary of the Invention" section of this application, from pg 4, line 4 through pg 5, line 27, the  
18 method is implemented through a gaming utility that runs on each of the player's electronic devices  
19 (e.g., personal computers or PCs) and interacts behind the scenes with an online messaging service.  
20 The host player is enabled by the online messaging service to create a list of contacts that include  
21 one or more other persons who may be interested in participating in playing a multiplayer online  
22 electronic game. When the host player logs onto the online messaging service, and loads the gaming  
23 utility, the host player is provided with the contact list, along with an availability status indicating  
24 which contacts in the list are available to play the multiplayer online game. Similarly, the persons  
25 who are the contacts in the host player's list can create their own list of contacts, and when logging  
26 onto the messenger service, will be provided with an indication of persons in their list of contacts  
27 who may be hosting a chat session, such as the host player.

28 A player hosting a chat session can select any of the contacts in their contact list to join the  
29 chat session, which will cause an electronic invitation to be sent to that contact. Preferably, the  
30 electronic invitation includes both a model dialog box and an audible announcement that is heard

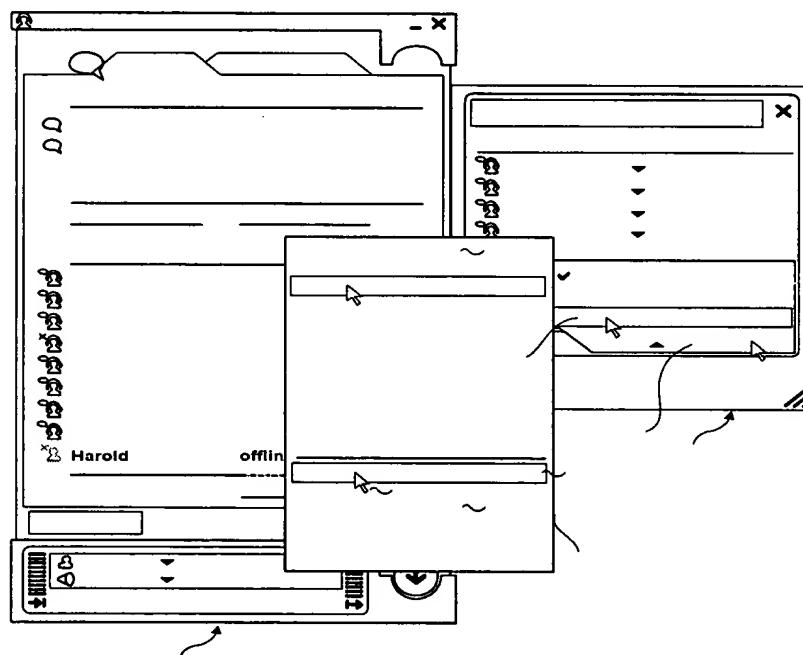
1 over headphones of a headset that is preferably worn by each player. The headset additionally  
2 includes a microphone 28 and is operatively coupled to a player's electronic device or computer 118  
3 through a channel controller device 18, as shown in FIGURE 2 of the application, reproduced below  
4 and explained in greater detail at pg 15, line 9 through line 23. In response to receiving the  
5 invitation, each recipient may selectively join or decline the chat session by clicking on a  
6 corresponding button in the dialog box.



27 Optionally, the recipient may toggle the channel controller device to a command and control  
28 mode and speak "Yes" or "No" into the microphone. The channel controller device also enables  
29 each chat session participant to control the other participants who can hear their voice, and includes  
30 an "All" channel button that enables all of the participants to hear each other, thereby enabling the

1 chat session participants to agree on a game they would like to play, and when the game should be  
2 started. In addition, each of the players is provided with a list of multiplayer online games they can  
3 automatically launch, based on a gaming profile for each player. After a desired group of players  
4 has joined the host in the chat session and agree on a game to play from among the games in their  
5 lists, the host player can automatically launch an instance of the selected multiplayer online game on  
6 each of the player's electronic devices or computers, thereby enabling the other players to participate  
7 in the game.

8 Much of the specification of the application on appeal explains the use of the gaming utility  
9 and the channel controller in connection with an online messaging service for initiating a chat  
10 session and joining players to the chat session. But the primary purpose of doing so is to facilitate  
11 joining the players in the chat session in the play of a multiplayer online game. Details of how the  
12 players are joined in playing an online game are provided in the specification at pg 23, line 13  
through pg 24, line 20, in connection with FIGURE 19, which is reproduced below.  
13



28 When all of the players the host player desires to have participate in a multiplayer online  
29 computer game have joined the host player in the chat session, the host player can launch an instance  
30 of certain types of DIRECTPLAY™ games on each of the chat session participant's computer by

1 activating "Chat Options" control 74, and selecting a "Start a Game" option 160. In response, a  
2 cascaded game selection menu 162 will be displayed, enabling the host to select one of a plurality of  
3 such games 164 that are listed in an upper portion of the menu, so that the selected game is  
4 automatically launched on all of the chat participants' computers that have that installed on their  
5 electronic device or computer. For other types of games that are not of the DIRECTPLAY™ type,  
6 the players in the chat session will have to agree upon a game to play (or be informed by the host of a  
7 game selected by the host that the host will be launching or has already launched), and each player will  
8 have to manually start an instance of the agreed-upon or host-selected game on that player's electronic  
9 device.

10 It will be apparent that the claimed invention on appeal preferably uses a chat session  
11 established through an online messaging service to enable a host player to invite players to  
12 participate in a multiplayer online game and facilitates the interaction between players in choosing  
13 the online game and in accepting or declining the invitation to participate. The method avoids the  
14 problems of the prior art, since it is not necessary for the host player or the other players to have  
15 specific knowledge of each other's IP address in order to join the player with the host player in  
16 playing a multiplayer online game. Use of the verbal chat facility of the messaging service as  
17 provided by the channel controller avoids the need for participants the chat session to enter text  
18 messages in regard to selecting an online game to play, or in regard to a person agreeing to  
participate in playing the online game selected.

19 Another aspect of the present invention is directed to a system that implements the steps of  
20 the method discussed above. The system includes a processor and memory for storing machine  
21 instructions executed by the processor to implement functions generally consistent with the steps of  
22 the method. In addition, another aspect of the present invention is directed to a computer-readable  
23 medium comprising a plurality of machine instructions that perform the method when the machine  
24 instructions are executed by a processor.

25 ISSUES PRESENTED FOR REVIEW

26 The only issue presented for review is whether Claims 1-38 are anticipated by U.S. Patent  
27 No. 6,179,713 under 35 U.S.C. 102(e).

28 GROUPING OF CLAIMS

29 The claims do not stand or fall together. Instead, Claims 1-13 stand or fall together;  
30 Claims 14-28 stand or fall together; Claims 29-32 stand or fall together; and Claims 33-38 stand or

fall together. The reasons for grouping the claims in this manner will be apparent from the discussion presented in the following section.

## ARGUMENT

**Rejection Under 35 U.S.C. § 102(e) over James et al.**

The Examiner has rejected Claims 1-38 as being anticipated by James et al., U.S. Patent No. 6,179,713 (hereinafter referred to simply as “James”). Since all claims in the application on appeal are rejected over James, it will perhaps be helpful to briefly discuss this reference before traversing the rejection on a claim-by-claim basis.

James is generally directed to a computer game that is played over a computer network, such as the Internet, and which enables the players coupled together in the game to input moves and to remain aware of the state of the game with the input/output functions of a web browser. The Abstract of James indicates that “the game can be played with substantially no other *game related software, plug-ins, or add-ons*” (emphasis added), and this point is repeated at col. 7, lines 43 through 52. Thus, James does not teach playing a multiplayer online game that is executed on each participant’s computer, since the only software running on each participant’s computer that is required for playing the game in James is a web browser. Players do not directly connect to each other in James, but instead play the game by connecting over the Internet to a game web server and database 10, as explained at col. 8, lines 29-36. There is no host player in James, since game web server and database 10 hosts the game for all players who interact with the server over a link to the game web server and database.

At col. 14, line 47 through col. 15, line 3, James discusses another similar embodiment, and mentions that in this embodiment, a database server 412 includes a game database 414 and a messaging database 416 at a game website 406. Also included at the game website is a messaging server 418. James explains here that the messaging server “receives communications from the various players or users 402, handles various player services such as e-mail communications, real time chat rooms, and providing encyclopedia or other game information.” However, James does not teach or suggest that there is any relationship between the real time chat rooms and web server 408, which “runs the game processor that processes all game moves and stores a current state of the game in the game database 414” (col. 14, lines 55-57). James also mention that “message server 418 is also operative for accessing the database server 412 to provide certain game state information such as the state of the game as of the most recently processed turn, and available resources/pricing

1 information" (col. 14, line 66 through col. 16, line 3). Col. 13, lines 1-8 of James also discuss a  
2 Command Center game interface browser window and notes that a "player may also choose to open  
3 a chat window at the bottom of the screen," but this reference to a chat window is clearly in the  
4 context of providing communications with other players who are already playing the game, since the  
5 Command Center is only displayed within the game environment.

6 Further details of the game environment and examples of a game that can be played using a  
7 web browser are taught by James, but these details do not appear relevant to the specific recitation of  
8 applicants' claimed invention. While James seems to indicate that in one embodiment, the game  
9 website supports chat sessions, there is simply no disclosure of any interaction between participants  
10 in a chat session in regard to playing a game, and no teaching or suggestion of initiating a game from  
11 within a chat session, so that the participants in the chat session become players of the game.

#### Specific Rejections

12 In rejecting Claim 1, the Examiner asserts that James teaches and describes a method for  
13 enabling a host player to select one or more other participants to join in playing a multiplayer online  
14 electronic game, as recited by appellants' preamble. However, James is not directed to playing any  
15 game that even includes a host player. Instead, the host in James is a game web server operating at a  
16 game website. Furthermore, there is no teaching or suggestion in James that any player actually is  
17 enabled to select other players to join in playing the game. Instead, in James, players choose to  
18 participate in the game by accessing the game website using their web browser. The Examiner then  
19 asserts that at col. 14, lines 35-62, James teaches "enabling the host player to create a list of contacts  
20 comprising one or more other persons who may be interested in participating in playing the  
21 multiplayer online electronic game," and "enabling the host player to select one or more of the other  
22 persons from among the list of contacts to participate in playing the multiplayer online electronic  
23 game," as recited in appellants' Claim 1. Yet, this section of James does not mention anything even  
24 remotely equivalent to a host player creating a list of contacts or enabling a host player to select  
25 persons from such a list. Indeed, James does not use a host player or provide any interaction  
26 between players to join players in playing a game. Appellants have generally discussed the  
27 embodiment referred to by the Examiner, and it should be apparent that there is not relationship  
28 between the referenced portion of James and the recited language of Claim 1, as asserted by the  
29 Examiner. Next, the Examiner cites to col. 4, line 64 through col. 5, line 21 of James as teaching  
30 "automatically sending an electronic invitation to each of the one or more other persons selected by

1 the host player, to join in playing the multiplayer online electronic game,” and “enabling each of the  
2 one or more other persons who receive the electronic invitation that was automatically sent, to  
3 selectively join the multiplayer online electronic game as a participant.” However, the portion of  
4 James cited to by the Examiner discusses how players can interact within the game, once the players  
5 connect to the game server and begin playing the game. There is no teaching or suggestion by James  
6 relating to any host player sending an invitation to any other person selected by the host player to  
7 join in playing the game and no teaching or suggestion that any person receives such an invitation or  
8 in response, selectively joins the game. Accordingly, there is simply no support for this rejection  
9 based on the cited art and it should be withdrawn.

10 In rejecting Claim 14, the Examiner again asserts that James teaches a “method for enabling  
11 a host player to select one or more other players to participate in a multiplayer online electronic  
12 game played using a plurality of electronic devices linked in communication over a communication  
13 network, each of said plurality of electronic devices being operated by a different player.” As noted  
14 above, there is no discussion in James about any player being a host player; instead, the host is a  
15 game web server at a game website. Also, James does not teach or suggest that any player selects  
16 other players to participate in an online game. Much of the preceding discussion traversing the  
17 rejection of Claim 1 is also applicable to the rejection of Claim 14, but there are other significant  
18 differences between Claim 14 and the prior art as discussed below, which lead appellants to include  
Claim 14 and its dependent claims in a second group from Claim 1 and its dependent claims.

19 The Examiner relies upon col. 13, line 2-line 8 of James as disclosing “enabling the host  
20 player to initiate a chat session.” However as noted above, this section of James only teaches that  
21 within the Command Center of the game, a player (but not a *host* player) can open a chat window.  
22 There is no teaching or suggestion in James that any player acting as a host player can open a chat  
23 window before becoming a participant in the game. The Examiner then cites to col. 14, line 47  
24 through col. 15, line 14 as disclosing “enabling the host player to invite one or more other players to  
25 join the chat session,” and “enabling any of the players who were invited by the host, to be a  
26 participant in the chat session.” As discussed above, this portion of James does not mention a host  
27 player, does not teach or suggest that any player issues an invitation to any other player to join in  
28 playing a game, and does not teach or suggest that any player so invited is enabled to participate in a  
29 chat session. The provision of a messaging server and messaging database in James appear to be in  
30 the context of chat messages during the game. Even if James teaches providing messaging server,

1 there is no disclosure or suggestion of the function steps recited in Claim 14 relating to issuing and  
2 accepting invitations to other to participate in a chat session.

3 Next, the Examiner cites col. 13, lines 10-36 of James as disclosing “automatically launching  
4 an instance of the multiplayer online electronic game on each electronic device being operated by  
5 any player participating in the chat session, said step of automatically launching being in response to  
6 a game initiating action performed by the host player so that any player participating in the chat  
7 session automatically becomes a participant in the multiplayer online electronic game.” The portion  
8 of James to which the Examiner cites discusses a game map window, use on an icon to represent  
9 each planet in the game, and use of map to select destinations for fleets, but there is no teaching or  
10 suggestion of anything equivalent to automatically launching an instance of a multiplayer online  
11 electronic game in this or any other portion of James. Therefore, it is apparent that the rejection of  
12 Claim 14 over James is improper and should be withdrawn.

13 In his rejection of Claim 29 over James, the Examiner states that the reference “teaches and  
14 describes a “method for enabling a host player to select one or more other players to participate in a  
15 multiplayer online electronic game played using a plurality of electronic devices linked in  
16 communication over a communications network, each of said plurality of electronic devices being  
17 operated by a different player,” as recited in the preamble of the claim. Yet, there is simply no  
18 teaching or suggestion of a host player, or of any player selecting other players to participate in a  
19 game within James. Although some steps recited in Claim 29 are similar to those of Claims 1 and  
20 14, it will be apparent that there are other steps that are different and are not taught or suggested by  
21 James. Accordingly, Claim 29 and its dependent claims are grouped separately from the other  
groups of claims identified above.

22 For example, Claim 29 recites “enabling the host player to initiate a voice chat session.” The  
23 Examiner asserts that this step of the claim is disclosed at col. 13, lines 2-8, which was discussed  
24 above. However, as noted above, there is no host player and James does not teach or suggest that  
25 any player initiates a *voice* chat session, even within the game environment. The Examiner next  
26 indicates that col. 8, lines 29-36 of James disclose “enabling the host player to invite one or more  
27 other players to join the voice chat session,” but this portion of the reference actually teaches that a  
28 player interacts with the game through a browser 16 “to submit moves to a data base 18 within the  
29 game server 10,” and “to receive information from the data base 18.” This portion further indicates  
30 that the several layers are established to “limit the player’s options to valid moves in a game.” Thus,

1 James does not teach enabling a host player to invite other players to join a voice chat session and  
2 would seem to teach away from this function, since such a function is not a valid move in a game.

3 The next citation is to col. 4, line 65 through col. 5, line 21 of James, which the Examiner  
4 relies upon as teaching "enabling any of the players who were invited by the host, to be a participant  
5 in the voice chat session." While this portion of James discusses providing a real-time chat area, it  
6 appears clear that the chat area is available to players who are already participants in the game and  
7 there is no teaching or suggestion in James that any player responds to an invitation by any player  
8 acting as a host player, to participate in a chat session.

9 Col. 8, lines 16-44 of James are cited by the Examiner as disclosing "enabling the host player  
10 to forward a network address corresponding to an electronic device being operated by the host to any  
11 other player participating in the voice chat session." While this portion of James discusses how  
12 TCP/IP and other aspects of communication are employed to enable players to connect their browser  
13 to a game web server, there is simply no teaching or suggestion therein of a host player forwarding a  
14 network address for an electronic device operated by the host player to any other player participating  
15 in a voice chat session, which is not surprising, since James does not mention a voice chat session.

16 Finally, the Examiner relies upon col. 14, line 47 through col. 15, line 14 of James as  
17 disclosing "transmitting a voice chat message from the host player to any other player participating  
18 in the voice chat session, said voice chat message identifying a multiplayer online electronic game  
19 that the host player will be launching or has already launched on the electronic device operated by  
20 the host player so that any other player participating in the voice chat session can selectively launch  
21 an instance of the multiplayer online electronic game on the electronic device operated by the player,  
22 so that any player participating in the chat session who selectively launches the multiplayer online  
23 electronic game becomes a participant in the multiplayer online electronic game." The portion of  
24 James cited to by the Examiner has been discussed at length above. James clearly does not refer to a  
25 voice chat session, does not teach or suggest that a host player identifies an online game in a voice  
26 chat message that will be launched (i.e., executed) or has already been launched, and does not teach  
27 or suggest that any other player in a chat session will then launch the online game to become a  
28 participant. James does not teach or suggest any game that is launched or executed on a player's  
29 own computer. Instead, the game is executed on a game server and players participate in the game  
30 in a web browser, but do not execute the game on their computer. Accordingly, it will be apparent  
that the rejection of Claim 29 over James is also unjustified and should be withdrawn.

1       Claim 33 is directed to “a system for enabling a host player to select one or more other players  
2 to participate in playing a multiplayer online electronic game played using a plurality of electronic  
3 devices linked in communication over a communications network, each of said plurality of electronic  
4 devices being operated by a different player.” For the reasons already stated, James does not relate to  
5 such a system, since the reference does not teach or suggest a host player, and does teach or suggest that  
6 any player invites any other players to participate in playing an online game. This claim and the claims  
7 that depend upon it are grouped separately from the other claims because the claims recites components  
8 that are not included in the other claims. Also, although many of the same bases for distinguishing over  
9 James that have already been raised are also applicable, this group of claims differs from James in  
several other respects, as will be apparent.  
10

11      Claim 33 recites “a display on which a user interface is implemented.” The Examiner cites  
12 James, col. 8, lines 45-59, which indeed refer to the display of a browser. The Examiner then cites col. 2,  
13 lines 51-65 as disclosing “a memory in which a plurality of machine instructions are stored.” The  
14 portion of James to which the Examiner cites discusses the problem (i.e., the limit on the number of  
15 players) when playing multiplayer games that are hosted by a computer associated with one of the  
16 players, in contrast to the invention of James, which is hosted by a game server at a game website. The  
17 claim next recites “a processor coupled to the memory for executing said plurality of machine  
18 instructions, said processor implementing a plurality of functions when executing the machine  
19 instructions,” and the Examiner cites to col. 1, lines 15-25 of James, which simply mention CPUs.  
20 However, this claim clearly distinguishes over James in regard to the functions that are implemented  
by the processor when executing the machine instructions.  
21

22      Appellants have already explained how the functions recited in Claim 33  
23 subparagraphs (c)(i)-(c)(iii) are not disclosed or suggested by James. Moreover, a further significant  
24 difference exists in regard to the function of “automatically launching an instance of the multiplayer  
25 online electronic game on each electronic device being operated by any player participating in the  
chat session, said step of automatically launching being in response to a game initiating action  
26 performed by the host player so that any player participating in the chat session automatically  
27 becomes a participant in the multiplayer online electronic game,” which is recited in  
28 subparagraph (c)(iv) of this claim. The Examiner cites to col. 13, lines 10-36 of James as disclosing  
29 this function, but for the reasons already discussed, this portion of James bears no relationship to the  
30 recited function, because it simply discusses details of a specific instance of a game, such as a game

1 map, a control button to re-center the map, scroll and zoom controls, planet icons, player fleets, etc.  
2 It is also important to understand that appellants' claim is directed to functions that are implemented  
3 on each player's electronic device. This last function provides for launching an instance of the  
4 multiplayer online electronic game on each electronic device, while in contrast, in James, the online  
5 game is executed on the game server at the gaming website, and only a web browser is executed on  
6 each player's computer. Only a single instance of the online game is implemented in James, since  
7 each browser only displays data transmitted from the game server, but does not actually launch an  
8 instance of the online game. Therefore, it will be apparent that appellants' Claim 33 is neither taught  
9 nor suggested by James, and this rejection should also be withdrawn.

10 Each of the claims dependent upon the independent claims discussed above have also been  
11 rejected by the Examiner. Having reviewed James and the portions cited by the Examiner in  
12 rejecting these claims, it is apparent that James does not provide any teaching or suggestion that  
13 would justify the Examiner's rejections. Just as was the case in the portions of James cited by the  
14 Examiner in rejecting the independent claims, the citations applied in rejecting the dependent claims  
15 are wholly without merit for that purpose, because James simply does not disclose the details recited  
16 in these dependent claims. Rather than taking the Board's time in a detailed review of each of these  
17 citations applied by the Examiner rejecting the dependent claims, appellants have chosen to  
18 primarily rely upon the distinctions already made in regard to the independent claims. The Board is  
19 invited to select any of the dependent claim rejections made by the Examiner and review the cited  
20 portion of James relied upon by the Examiner in making the rejection; it will be apparent that terms  
21 mentioned in James and by appellants' dependent claims are either not equivalent when viewed in  
22 context, or that James simply does not teach or suggest the details recited by appellants' claims.

23 Since all of the dependent claims inherently include the same recitation as the claims on  
24 which they depend, they are patentable for at least the same reasons as the independent claims on  
25 which they are ultimately based. Accordingly, each of the dependent claims is patentable for at least  
26 the same reasons discussed above in connection with the relevant independent claim (Claim 1, 14,  
27 29, or 33).

#### CONCLUSION

28 In rejecting all of the claims in the application on appeal, it appears that the Examiner has  
29 simply identified James as being relevant because it discloses a multiplayer online game. However,  
30 the Examiner has failed to appreciate the many differences that exist between James' disclosure and

1 appellants' claimed invention. James discloses a game that achieves massive multiplayer capability  
2 by using one or more game servers to host the game and by enabling each player to access the game  
3 website of the game server through a web browser that is running on the player's computer.  
4 Although James mentions that one embodiment of the game website can provide real-time chat  
5 capability, it appears that the chat is provided for those who connect to the website and are involved  
6 in playing the game. In any case, there is no disclosure or suggestion in James of a host player who  
7 creates a contact list of persons who might be selectively invited to join in playing a multiplayer  
8 online electronic game, and no suggestion or disclosure of using a chat session to select players to  
9 participate in an online, particularly a voice chat session. These and other differences discussed  
10 above clearly show that the Examiner's rejection of appellants' claims over James is not justified  
11 and the Board is respectfully requested to instruct the Examiner to withdraw the rejection and pass  
12 this application to issue without further delay.

13 Respectfully submitted,

14   
15

16 Ronald M. Anderson  
17 Registration No. 28,829

18 RMA:ssa

19 EXPRESS MAIL CERTIFICATE

20 Express Mail Label No. EV289322234US Date of Deposit: January 26, 2004  
21 I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to  
22 Addressee" service under 37 C.F.R. § 1.10 on the date indicated above and is addressed to the Commissioner for  
Patents, Alexandria, Virginia 22313-1450.

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## APPENDIX

## Claims on Appeal

1. A method for enabling a host player to select one or more other participants to join in playing a multiplayer online electronic game, comprising the steps of:

(a) enabling the host player to create a list of contacts comprising one or more other persons who may be interested in participating in playing the multiplayer online electronic game;

(b) enabling the host player to select one or more of the other persons from among the list of contacts to participate in playing the multiplayer online electronic game;

(c) automatically sending an electronic invitation to each of the one or more other persons selected by the host player, to join in playing the multiplayer online electronic game; and

(d) enabling each of the one or more other persons who receive the electronic invitation that was automatically sent, to selectively join the multiplayer online electronic game as a participant.

2. The method of Claim 1, further comprising the step of providing an availability status for each person in the list of contacts so as to enable the host player to identify persons in the list of contacts who are currently available to participate in playing the multiplayer online electronic game.

3. The method of Claim 2, further comprising the step of enabling each person in the list of contacts to select an availability status indicating the person's availability for participating in playing a multiplayer online electronic game.

4. The method of Claim 1, wherein the host player is enabled to build a list of chat contacts through use of an online messaging service, said list of chat contacts automatically being parsed to create the list of contacts.

5. The method of Claim 4, wherein at least one person in the list of contacts is not currently logged into the online messaging service and has been invited to join the multiplayer online electronic game, further comprising the step of automatically forwarding the electronic invitation to join the multiplayer online electronic game to said at least one person when said at least one person logs into the online messaging service.

6. The method of Claim 4, wherein selection of game participants and voice chat communications before and during game play is facilitated by a gaming utility that runs on an electronic device operated by each game participant and at least one person in the list of contacts has

been invited to join the multiplayer online electronic game and has not started an instance of the gaming utility on the electronic device(s) operated by said at least one person, further comprising the step of automatically forwarding the electronic invitation to join the multiplayer online electronic game to said at least one person when said at least one person launches an instance of the gaming utility on the electronic device(s) operated by said at least one person.

7. The method of Claim 4, further comprising the step of providing an availability status for each person in the list of contacts so as to enable the host player to identify persons in the list of contacts who are currently available for playing the multiplayer online electronic game, said availability status being determined by the online messaging service.

8. The method of Claim 1, wherein the electronic invitation comprises a verbal message.

9. The method of Claim 8, further comprising the step of enabling the electronic invitation to be accepted by a person invited to join the game through a verbal response spoken by said person.

10. The method of Claim 1, further comprising the steps of providing a list of multiplayer online electronic games to the host player; and enabling the host player to select the multiplayer online electronic game from said list of multiplayer online electronic games.

11. The method of Claim 1, further comprising the steps of:

(a) providing a user interface including a first display area on which the list of contacts is displayed and a second display area corresponding to a voice chat session; and

(b) enabling the host to select the one or more contracts to invite to join the voice chat session by selecting one or more contacts from among the list of contacts displayed in the first display area and dragging and dropping them onto the second display area.

12. The method of Claim 11, wherein a plurality of contacts can be selected and dragged and dropped onto the second display area at one time.

13. A computer readable medium having computer executable instructions for performing the steps recited in Claim 1.

14. A method for enabling a host player to select one or more other players to participate in a multiplayer online electronic game played using a plurality of electronic devices linked in communication over a communications network, each of said plurality of electronic devices being operated by a different player, the method comprising the steps of:

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- (a) enabling the host player to initiate a chat session;
  - (b) enabling the host player to invite one or more other players to join the chat session;
  - (c) enabling any of the players who were invited by the host, to be a participant in the chat session; and
  - (d) automatically launching an instance of the multiplayer online electronic game on each electronic device being operated by any player participating in the chat session, said step of automatically launching being in response to a game initiating action performed by the host player so that any player participating in the chat session automatically becomes a participant in the multiplayer online electronic game.

15. The method of Claim 14, further comprising the step of providing a network address of the electronic device the host player is using and operating so as to enable the host player to invite one or more other players to join in playing the multiplayer online electronic game, by referencing said network address.

16. The method of Claim 14, wherein the host player is a member of an online messaging service that enables the host player to build a player contact list comprising a list of one or more players with whom the host prefers to chat and/or play multiplayer online electronic games, further comprising the steps of:

- (a) displaying the player contact list to the host player; and
  - (b) enabling the host player to select one or more other players to participate in playing the multiplayer online electronic game from the player contact list.

17. The method of Claim 16, further comprising the step of providing an availability status for each player in the player contact list.

18. The method of Claim 16, further comprising the step of enabling each player to select an availability status indicating the player's availability to join a chat session.

19. The method of Claim 16, further comprising the steps of:

- (a) providing a user interface including a first display area on which the list of contacts is displayed and a second display area corresponding to a voice chat session; and
  - (b) enabling the host to select the one or more contracts to invite to join the voice chat session by selecting one or more contacts from among the list of contacts displayed in the first display area and dragging and dropping them onto the second display area.

1       20. The method of Claim 19, wherein a plurality of contacts can be selected and dragged  
2 and dropped onto the second display area at one time.

3       21. The method of Claim 14, further comprising the step of sending an electronic  
4 invitation to join the chat session to each of the one or more players invited by the host player to join  
5 the chat session.

6       22. The method of Claim 21, wherein the electronic invitation includes an audible  
7 announcement apprising any player receiving the electronic invitation that the host player has invited  
8 the player to join the chat session.

9       23. The method of Claim 22, further comprising the step of enabling the electronic  
10 invitation to join the chat session to be accepted by a recipient through a verbal response spoken by  
11 the recipient, whereupon said recipient becomes a participant in the chat session.

12       24. The method of Claim 14, wherein each player is a member of an online messaging  
13 service that enables the player to build a player contact list comprising a list of one or more players  
14 with whom the player prefers to chat and/or play multiplayer online computer games, further  
15 comprising the step of:

16               (a) providing a list of chat sessions that are being hosted by at least one other  
17 player contact in a player contact list built by the player; and

18               (b) enabling the player to join a chat session appearing in the list of chat sessions.

19       25. The method of Claim 14, further comprising the step of providing a headset  
20 operatively coupled in communication with each of said plurality of electronic devices, each headset  
21 comprising at least one sound transducer and a microphone employed by each players to participate  
22 in a voice chat session.

23       26. The method of Claim 25, further comprising the step of enabling a player to transmit  
24 voice chat data to all of the other players who have joined the voice chat session.

25       27. The method of Claim 14, further comprising the steps of providing a list of  
26 multiplayer online electronic games; and enabling the host player to select the multiplayer online  
27 electronic game that will be played.

28       28. A computer readable medium having computer executable instructions for  
29 performing the steps recited in Claim 14.

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1        29. A method for enabling a host player to select one or more other players to participate  
2 in a multiplayer online electronic game played using a plurality of electronic devices linked in  
3 communication over a communications network, each of said plurality of electronic devices being  
4 operated by a different player, the method comprising the steps of:

5                (a) enabling the host player to initiate a voice chat session;  
6                (b) enabling the host player to invite one or more other players to join the voice  
7 chat session;

8                (c) enabling any of the players who were invited by the host, to be a participant in  
9 the voice chat session;

10               (d) enabling the host player to forward a network address corresponding to an  
11 electronic device being operated by the host to any other player participating in the voice chat  
12 session; and

13               (e) transmitting a voice chat message from the host player to any other player  
14 participating in the voice chat session, said voice chat message identifying a multiplayer online  
15 electronic game that the host player will be launching or has already launched on the electronic  
16 device operated by the host player so that any other player participating in the voice chat session can  
17 selectively launch an instance of the multiplayer online electronic game on the electronic device  
18 operated by the player, so that any player participating in the chat session who selectively launches  
19 the multiplayer online electronic game becomes a participant in the multiplayer online electronic  
game.

20        30. The method of Claim 29, wherein the host player is a member of an online messaging  
21 service that enables the host player to build a player contact list of one or more players with whom  
22 the host prefers to chat and/or play multiplayer online computer games, further comprising the steps  
23 of:

24               (a) providing the player contact list to the host player; and  
25               (b) enabling the host player to select one or more players to participate in the  
26 multiplayer online electronic game from the player contact list.

27        31. The method of Claim 30, further comprising the step of providing an availability  
28 status for each player in the player contact list.

29        32. A computer readable medium having computer executable instructions for  
30 performing the steps recited in Claim 29.

1       33. A system for enabling a host player to select one or more other players to participate in  
2 playing a multiplayer online electronic game played using a plurality of electronic devices linked in  
3 communication over a communications network, each of said plurality of electronic devices being  
4 operated by a different player and including:

- 5             (a) a display on which a user interface is implemented;
- 6             (b) a memory in which a plurality of machine instructions are stored; and
- 7             (c) a processor coupled to the memory for executing said plurality of machine  
instructions, said processor implementing a plurality of functions when executing the machine  
instructions, including:
  - 9                 (i) enabling the host player to initiate a chat session;
  - 10               (ii) enabling the host player to invite one or more other players to join the  
chat session;
  - 12               (iii) enabling any of the players who were invited by the host, to be a  
participant in the chat session; and
  - 14               (iv) automatically launching an instance of the multiplayer online  
electronic game on each electronic device being operated by any player participating in the chat  
session, said step of automatically launching being in response to a game initiating action performed  
by the host player so that any player participating in the chat session automatically becomes a  
participant in the multiplayer online electronic game.

19       34. The system of Claim 33, wherein the host player is a member of an online messaging  
20 service that enables the host player to build a player contact list of one or more players with whom  
21 the host may desire to play multiplayer online computer games, and wherein execution of the  
22 plurality of machine instructions further implements the functions of:

- 23             (a) obtaining the player contact list from the online messaging service;
- 24             (b) displaying the player contact list to the host player; and
- 25             (c) enabling the host player to select one or more players to participate in the  
multiplayer online electronic game from the player contact list.

27       35. The system of Claim 33, wherein each electronic device includes:

- 28             (a) a microphone operatively coupled to the electronic device and which produces  
audio signals in response to words spoken by a user into the microphone; and

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(b) at least one sound transducer operatively coupled to the electronic device so as to replicate sounds corresponding to an audio data signal received over the communications network by the electronic device to which said at least one sound transducer is operatively coupled.

36. The system of Claim 35, wherein execution of the plurality of machine instructions further implements the function of sending an electronic invitation to join the chat session to a player invited by the host player to join the chat session.

37. The system of Claim 36, wherein the electronic invitation causes an audible announcement to be produced with said at least one sound transducer apprising each recipient of the electronic invitation that the host player has invited the recipient to join the chat session.

38. The system of Claim 37, wherein execution of the plurality of machine instructions further implements the function of enabling the electronic invitation to be accepted by a recipient through use of a verbal response spoken into the microphone by the recipient.